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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,798	01/23/2004	Joshua William Johnson	S1011/20171	7933

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EXAMINER

BALDWIN, GORDON

ART UNIT	PAPER NUMBER
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1775

MAIL DATE	DELIVERY MODE
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07/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/763,798	Applicant(s) JOHNSON, JOSHUA WILLIAM	
	Examiner Gordon R. Baldwin	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 7-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowen (Pat. No. 206, 387), and further in view of Del Mas (Pat. No. 2,760,303)

Consider claim 1,3, 7, 16, 17, 18 Bowen teaches an artificial plant acting as an ornament with a stalk or trunk member along with the blooms of a flower or plant acting as the head member (Col. 1 Para. 2 and 3) being connected by a spirally curved wire (in the shape of a spring), and is considered to be a spring, due to Webster's dictionary definition defining "wire" as a metal in the form of a very flexible thread or slender rod. (Col. 3 Para. 17) The ability of the stalk and head member to return to their original configuration after moving is considered to be a known feature of a spring's nature, in that, the spring will return items connected to it to their original position. This action is due to the spring's ability to apply counteracting forces to position the items connected to the spring in a similar position to what they were prior to the movement being applied to the stalk/head members.

Bowen does teach the use of a tapering projection pin, used to connect the stalk to the bloom (Col. 3 Para. 18), but the projection is not described as being threaded.

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However, Del Mas teaches an ornamental figure with interconnected means, which render various portions of the body movable in relation to one another and these portions are connected by coil springs. The coil springs connect the different portions of the body by engaging the body by tapered pegs with spirally deposited tapered threads (Fig. 11), which hold the spiral coil sections to the structure. (Col. 3 lines 59-70 and Col. 4 lines 1-10) It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the artificial plant in Bowen with the tapered threaded screw and tapered threads of Del Mas to provide a more secure attachment for the spring and flower bloom to the stalk section.

As for the Bowen reference being plant shaped or fungus shaped, since the difference between the fungus taught by the applicant and the plant taught by Bowen is only a design choice, the use of a fungus is not considered to render the claimed invention patentable over the prior art. The court has found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. (In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947))

Consider claim 2, Bowen teaches the use of a spirally curved wire (in the shape of a spring) and it is considered to be elongated and it is connected to the head (or flower blossom section) and to the stalk. (Figure 1)

Consider claims 4 and 5, Bowen is considered to teach the use of a spring, Bowen and Del Mas teach the use of coiled springs but neither teach that the spring is

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to be made of stainless steel or a corrosion resistant metal. However, the use of stainless steel, rubber or plastics is considered to be a known material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use stainless steel or rubber or plastics, since it has been held to be within the general skill of a worker in the art to select known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416

Consider claim 8, while Bowen's examples in figure (1) do not show a curved underside, the floral designs on F 2 and F3 are considered to have the ability to be contorted, so that they may form a head member that is curved and having an underside with an apex, because such a change in configuration is considered to be an obvious design choice. Additionally, the flower of F2 shows a connection that leads from where an apex on the underside would be formed and moving down toward the spring (flexible connection means) at fx2.

Additionally, the structure of Del Mas (Fig. 3) also shows the lower body portion (19), which is considered to be curved with an apex on the underside, wherein the underside carries the connection part (threaded peg or pin (32)). The peg is attached to the connective mean (coiled spring or spinal column (29)). (Col. 3 lines 1-10)

Consider claim 9, under Bowen, the head member of F2 is considered to taper down toward fx2 and f2, as it goes toward the connection part of fx2. (Fig. 1)

Additionally, Del Mas teaches that the coil springs connect the different portions of the

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body by engaging the body by tapered pegs with spirally deposed tapered threads (Fig. 11), which hold the spiral coil sections to the structure. (Col. 3 lines 59-70 and Col. 4 lines 1-10)

Consider claim 10, Bowen discloses the claimed invention except for a stalk member having a socket at the end of it. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the socket in the stalk rather than the socket in the base (as shown in figure 1), since it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

Consider claim 11, Bowen teaches in figure (1) that the stack gains width as it goes down toward the base to give a wider base.

Consider claim 12, Bowen teaches a spike being attached to the base of the stalk, which is then inserted into the socket of the base. (Fig. 1)

Consider claim 13, Bowen discloses the claimed invention except for the members being made of pottery. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use pottery to make the head member and stalk member, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416.

Consider claim 14, it would have been obvious to a person of ordinary skill in the art to use a weather resistant material to prevent degradation upon exposure to elements.

Consider claim 15, In Bowen, the flower head would be moveable in any direction. Additionally, the appendages of Del Mas are also considered to be movable in any direction, due to the coiled spring used, which gives the appendages a wide range of motion.

Consider claim 19, Bowen teaches an artificial plant acting as an ornament with a stalk or trunk member along with the blooms of a flower or plant acting as the head member (Col. 1 Para. 2 and 3) being connected by a spirally curved wire (in the shape of a spring), and is considered to be a spring, due to Webster's dictionary definition defining "wire" as a metal in the form of a very flexible thread or slender rod. (Col. 3 Para. 17) The ability of the stalk and head member to return to their original configuration after moving is considered to be a known feature of a spring's nature, in that, the spring will return items connected to it to their original position. This action is due to the spring's ability to apply counteracting forces to position the items connected to the spring in a similar position to what they were prior to the movement being applied to the stalk/head members.

Bowen does teach the use of a tapering projection pin, to use to connect the stalk to the bloom (Col. 3 Para. 18), but the projection is not described as being threaded. However, Del Mas teaches an ornamental figure with interconnected means, which render various portions of the body movable in relation to one another and these portions are connected by coil springs. The coil springs connect the different portions of the body by engaging the body by tapered pegs with spirally deposed threads (Fig. 11), which hold the spiral coil sections to the structure. (Col. 3 lines 59-70 and Col. 4 lines

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1-10) It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the artificial plant in Bowen with the tapered threaded screw of Del Mas to provide a more secure attachment for the spring and flower bloom to the stalk section.

While Bowen's examples in figure (1) do not show a curved underside, the floral designs on F 2 and F3 are considered to have the ability to be contorted, so that they may form a head member that is curved and having an underside with an apex, because such a change in configuration is considered to be an obvious design choice. Additionally, the flower of F2 shows a connection that leads from where an apex on the underside would be formed and moving down toward the spring (flexible connection means) at fx2.

Additionally, the structure of Del Mas (Fig. 3) also shows the lower body portion (19), which is considered to be curved with an apex on the underside wherein the underside carries the connection part (threaded peg or pin (32)), which is attached to the connective mean (coiled spring or spinal column (29)). (Col. 3 lines 1-10)

As for the Bowen reference being plant shaped or fungus shaped, since the difference between the fungus taught by the applicant and the plant taught by Bowen is only a design choice, the use of a fungus is not considered to render the claimed invention patentable over the prior art. The court has found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. (In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947))

Response to Arguments

Applicant's arguments filed 4/25/2007 have been fully considered but they are not persuasive.

The applicant's argument in regard to Bowen or Del Mas lacking a specific teaching of a fungus-shaped artificial ornament is not considered to be persuasive. The argument is not persuasive because the teaching of fungus-shaped article versus a plant-shaped article is considered to be only a design choice in the shape of the article and is not recognized as a patentable distinction over the prior art. The court has found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. (In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) As for the argument explaining the differences between live plants versus living fungi, this argument is not considered to be germane to an argument involving plastic or artificial articles.

Regarding applicant's arguments against the tapering peg (or screw) and threads of Del Mas, the peg (25) having the screw threads (17) of Del Mas are considered to taper as much as the applicant's teaching in the specification and the drawings. Portion (26) in figure 11 of Del Mas shows a tapering of the peg (25) up to the location of the first thread, which shows an increase in the diameter of the peg (25), which is considered to show a gaining of width, thereby showing a tapered peg (25). As for the tapered screw threads, since the threads (17) of Del Mas rise and fall from the initial taper portion (26) of the peg (25) (or screw), in the same way as the applicant's do in

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figure 2 of the applicant's drawings. Therefore, Del Mas is also considered to teach the use of tapered screw threads as claimed by the applicant.

Regarding the applicant's argument against the combination of Bowen and Del Mas, Del Mas is used to teach a connective feature (tapering screw and threads with a spring) and not the outward aesthetic design of Del Mas, therefore Del Mas is considered to be a proper combination. While Del Mas may not specifically teach an incentive or direction to use a tapered screw thread in the field of garden ornaments, Del Mas does show a connective means between a decorative article (the lower torso of the toy figure) and a secondary decorative article (the foot of the toy figure) utilizing a spring, threads and a screw to secure the two articles together in the same manner as the applicant's claimed invention. In this aspect, it would have been obvious to a person of ordinary skill in the art to combine Bowen and Del Mas.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon R. Baldwin whose telephone number is (571)272-5166. The examiner can normally be reached on M-F 7:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GRB


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SUPERVISORY PATENT EXAMINER
7/23/14